



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/565,955	01/26/2006	Lutz Wolfgang Gruneberg	051082	8456
20306 7590 04/03/2008 MCDONNELL BOEHNEN HULBERT & BERGHOFF LLP 300 S. WACKER DRIVE 32ND FLOOR CHICAGO, IL 60606				
EXAMINER				
ZEWDU, MELESS NMN				
ART UNIT		PAPER NUMBER		
2617				
MAIL DATE		DELIVERY MODE		
04/03/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/565,955

Applicant(s)

GRUNBERG ET AL.

Examiner

Meless N. Zawdu

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 January 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SE/US)
Paper No(s)/Mail Date 1/26/06
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____

DETAILED ACTION

1. This action is the first on the merit of the instant application.
2. Claims 1-15 are pending in this action.

Priority

Examiner notes that applicant has filed a foreign priority claim based on a US 60/491,463 (provisional application) filed on 7/31/03, which is inappropriate. Examiner also notes that applicant has filed a nation stage application, under 35 U.S.C 371, designating/electing the United States. Examiner would like to know, why, how and the venue under which the foreign priority is claimed.

Drawings

The drawings are objected to because the labeling on the components is not readable. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet,

and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

The abstract of the disclosure is objected to because it is not provided in a separate paragraph as required. Correction is required. See MPEP § 608.01(b).

Claim Objections

Claims 1015 are objected to because of the following informalities: they are not in the US standard. Appropriate correction is required.

Claims 4, 6, 9, 13, and 15 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim does not further limit a preceding claim from which it depends . See MPEP § 608.01(n).

Claims 2, 3, 11 and 12 are objected to because of the following informalities: a colon (:) needs to be placed after the word, "include". Appropriate correction is required.

Claims 1, 5-12 and are objected to because of the following informalities: features need to be separated by semi-colon or (;). Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 4-10 and 13-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Cover et al. (Cover) (US 7,155,479 B2).

As per claim 1: Cover discloses a system for handling email requests from a terminal (see col. 4, lines 51-61), the system comprising an email proxy (see col. 7, lines 14-220, and a database (see col. 7, lines 55-64), the email proxy being arranged to communicate with the database (see col. 2, line 61-col. 3, line 22), wherein the email proxy is arranged to detect a network address of the terminal (see col. 2, lines 41-60; col. 9, line 61-col. 10, line 5), and retrieve email configuration settings from the

database (see col. 7, line 55-col. 8, line 8), using the network address of the terminal (see col. 8, lines 49-67; col. 9, lines 11-24), the email proxy further being arranged to communicate with an email server, using the email configuration settings/values (see (see col. 14, lines 25-col. 15, lines 15). Cover also discloses that a central sever could include LDAP (see col. 1, lines 50-64).

As per claim 4: Cover discloses a system, wherein the database comprises a mapping of the network address of the terminal to an identity of a user (see col. 8, line 49-col. 9, line 10; col. 7, line 55-64; col. 8, lines 23-37).

As per claim 5: Cover discloses a system, wherein a first database comprises the mapping of the network address, of the terminal to the identity of the user (see col. 9, lines 1-10; col. 10, lines 39), and a second database (1 O) comprises the email configuration settings/values (see col. 8, lines 23-37).

As per claim 6: Cover discloses a system, wherein a first email proxy is used to handle email requests for retrieving email messages (see col. 14, lines 27-62), and a second email proxy is used to handle email requests for sending email messages.(see col. 15, lines 27-42).

As per claim 7: some of the features of claim 7 are similar to the features of claim 1 and are rejected on the same ground as claim 1. Cover discloses the difference features --- forwarding the email retrieval request to an email server using the email configuration settings/values/attributes (see col. 14, line 27-col. 15, line 15), retrieve a

requested email message from the email server and forwarding the requested email message to the terminal (see col. 15, lines 26-50).

As per claim 8: some of the features of claim 8 are similar to the features of claim 1 and are rejected on the same ground as claim 1. Cover also discloses the difference features --- modifying the email request using the email configuration settings (values/attributes) and forwarding the modified email sending request to an email server using the configuration settings (values/attributes) (see col. 8, lines 59-67).

As per claim 9: Cover discloses a terminal for use with a system, the terminal being provisioned with default configuration settings for sending or retrieving email messages, the default configuration settings being the same for mobile terminals within a network (see col. 15, lines 4-15, wherein the mobile terminal is arranged to send or retrieve email messages using the default configuration settings (see col. 5, lines 26-39).

As per claim 10: the features of claim 10 are similar to the features of claim 1, except claim 10 is broader than claim 1. Besides, claim similarity, the specific reads on the broad. Thus, claim 10 is rejected on the same ground as claim 1.

As per claim 13: the feature of claim 13 is similar to the feature of claim 4. Hence, claim 13 is rejected on the same ground as claim 4.

As per claim 14: the feature of claim 14 is similar to the feature of claim 5. Hence, claim 14 is rejected on the same ground as claim 5.

As per claim 15: the feature of claim 15 is similar to the feature of claim 6. Hence, claim 15 is rejected on the same ground as claim 6.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-3 and 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cover as applied to claims 1 and 10 above, and further in view of applicant's admitted prior art (APA).

As per claim 2: but, Cover does not explicitly teach about email configuration settings including -- a name of an email server, and a username and a password for accessing the email server, as claimed by applicant. However, applicant in, in the same field of endeavor, teaches that -- a name of an email server, a user name and a password are known to be used for email retrieval (see page 2, lines 1-4. (7)). Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the teaching of Cover with the using --- a name of an email server, a user name and a password are known to be used for email retrieval is known in the art as evidenced by applicant's use of the same.

As per claim 3: the APA teaches a system, wherein the email configuration settings further include:

a full name of a user (see page 2, lines 16-20), and
an email address of the user (see page 2, lines 16-20). A name includes a full name
because the APA does not exclude any part of a name.

As per claim 11: the features of claim 11 are similar to the features of claim 2.
Hence, claim 11 is rejected on the same ground and motivation as claim 2.

As per claim 12: the features of claim 12 are similar to the features of claim 3.
Hence, claim 12 is rejected on the same ground as claim 3.

Conclusion

Any inquiry concerning this communication or earlier communications from the
examiner should be directed to Meless N. Zewdu whose telephone number is (571)
272-7873. The examiner can normally be reached on 8:30 am to 5:00 pm..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's
supervisor, Bost Dwayne D can be reached on (571) 272-7023. The fax phone number
for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Any inquiry of a general nature relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2600.

/Meless N Zewdu/
Primary Examiner, Art Unit 2617
4/4/2008